

REMARKS

This is a response to the office action mailed Sept. 19, 2005. Claims 90-94 were rejected under 35 U.S.C. 102 (e) as being anticipated by Pfoest et al. as evidenced by Murray et al.

Since the examiner is making an anticipation rejection under 35 U.S.C. 102, it is not clear what is meant by the phrase: "as evidenced by". Rejections under 35 U.S.C. 102 must find all of the elements of the rejected claim in a single reference, device or process. In re Donohue, 226 USPQ 619 (Fed. Cir. 1985). "A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference". M.P.E.P. 2131.

In the rare case that an additional reference is used, it cannot be used to supply a claim element not found in the first reference, but merely to interpret the allegedly anticipating reference and shed light on what it would have meant to those skilled in the art at the time.

Studiengesellschaft Kohle v. Dart Indus., Inc., 220 USPQ 841 (Fed. Cir. 1984). The M.P.E.P. states that an additional reference can only be used for very limited purposes: for example to show that a characteristic not

disclosed in the reference is inherent. M.P.E.P. 2131.01.

"To serve as an anticipation when the reference is silent about an asserted inherent characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would have been so recognized by persons of ordinary skill". M.P.E.P. 2131.01(III), citing Continental Can Company USA v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The examiner clearly admits that the Pfof reference "does not explicitly teach the details of the fiber optic structure,..." (Office action, p. 3 line 4). In fact, Pfof does not teach that any of his structure even conducts light, let alone forms an optical structure. In fact, Pfof teaches away from an optical structure by saying that the layers could contain LEDs or fiber optics (and hence not be themselves an inherent optical structure). (Pfof Col. 11, line 43).

The examiner is improperly using the Murray reference, not to shed light on what Pfof would have meant to a person of skill in the art at the time of the invention, or to show that the characteristic is inherent, but rather to

supply the missing element. This is an improper rejection under 35 U.S.C. 102. Murray in no way teaches what Pfof means to one skilled in the art or shows that Pfof contains an inherent optical structure.

Additionally, since Murray teaches an oxygen sensor that is not related in any way to a biological sensor, the two disclosures are not even in the same art. Murray in fact teaches the use of a standard piece of fiber optic with a sensing material disposed on the waveguide, not an optical structure. Murray cannot be combined with Pfof to supply the missing optical structure in Pfof.

For these reasons, the applicant believes that the claims are allowable. The examiner is respectfully requested to place the case into condition for allowance at his earliest convenience.

Respectfully Submitted

A handwritten signature in cursive script that reads "Clifford Kraft".

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